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PTO/SB/96 (09-04)  
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Novotny et al.

Application No./Patent No.: 09/990,681 Filed/Issue Date: November 14, 2001

Entitled: Fully Scalable Computer Architectures for Parallel Discrete Event

Mississippi State University, a University  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

in the patent application/patent identified above by virtue of either:

A ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

B ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: Novotny et al. To: Florida State University  
The document was recorded in the United States Patent and Trademark Office at  
Reel 012604, Frame 0757, or for which a copy thereof is attached.
2. From: Florida State University To: Mississippi State University  
The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☒ Copies of assignments or other documents in the chain of title are attached.  
[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Malvern U. Griffin III  
Signature

May 5, 2005  
Date

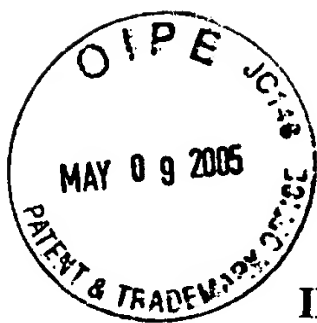
Malvern U. Griffin III  
Printed or Typed Name

404.853.8233  
Telephone Number

Attorney  
Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**INTER-INSTITUTIONAL AGREEMENT**  
**Version 3.4.05**

THIS AGREEMENT, effective as of the date last executed by both parties, is made by and between Mississippi State University ("MSU"), a public educational institution established under the laws of the State of Mississippi, having a place of business located at Mississippi State, MS 39762 and the Florida State University Research Foundation, Inc. ("FSURF"), a direct support organization for the Florida State University ("FSU"), organized under the laws of the State of Florida, and having a place of business located at 97 S. Woodward Ave., Box 15, Tallahassee, FL 32306-4166, and the Florida State University, a public university in Florida and located at 109 Westcott Building, Tallahassee, FL 32306-1336;

WHEREAS, Mark A. Novotny and Gyorgy Korniss are named inventors on the Invention and were employees of FSU at the time the Invention was made ("Inventor");

WHEREAS, Inventors have assigned all right, title, and interest in the Invention to FSU, and whereby the Inventors have agreed to cooperate with and assist in preparing, filing, prosecuting, and maintaining patent applications and patents relating to the Invention throughout the world;

WHEREAS, except for the Federal Government, under FAR clause 52.227-11, Retention of Patent Rights by Contractor (short form), FSU is under no obligation to anyone with respect to the Invention; and

WHEREAS, Mark A. Novotny is an employee of MSU; and

WHEREAS, FSU desires that its interests in the said Invention(s) be merged with, and be administered by MSU; and

WHEREAS, FSURF is the entity responsible for managing licensing revenues and royalties on behalf of FSU.

NOW, THEREFORE, in consideration of the mutual promises set forth herein and rights obtained thereby, it is agreed as follows:

## **1. DEFINITIONS**

1.1 "Invention(s)" means patent application 09/990,681, Fully Scalable Computer Architecture together with any divisions, continuations, or continuations-in-part thereof, and any patents issued thereon or reissues or extensions thereof.

1.2 “Net Revenues” means Gross Revenue, less eight thousand five hundred dollars, less Expenses incurred but not recovered to date by either FSU or MSU. Expenses incurred to date by FSU, but not recovered, are \$11,715.71.

1.3 “Royalties” mean proceeds received either by MSU or FSU/FSURF from separate licensing arrangements for Invention(s) entered into after either party has terminated this Agreement pursuant to Section 8.

1.4 “Expenses” means all reasonable and actual out-of-pocket costs incurred by MSU or FSU/FSURF for the preparation, filing, prosecution, and licensing of patent applications, for litigation, and the maintenance of resulting patents.

1.5 “Sponsor” means the National Science Foundation under Grant DMR-987155, a Federal Government entity that provided funds used to make the Invention(s).

1.6 “Gross Revenue” means gross proceeds received by MSU from the licensing of said Invention(s) pursuant to this Agreement.

## **2. OWNERSHIP AND PATENT PROSECUTION**

2.1 MSU shall prosecute, and maintain patent applications and patents embodying the Invention(s) and shall promptly provide to FSU all serial numbers and filing dates, together with copies of all such applications, including copies of all Patent Office Actions, responses, and all other Patent Office communications.

2.2 MSU shall make an election with respect to foreign filing. If any foreign patent applications are filed, MSU shall promptly provide to FSU all serial numbers and filing dates. MSU also shall provide to FSU copies of foreign patent applications and Patent Office actions as FSU may request in the course of prosecution.

2.3 FSU hereby consents to the assignment of its undivided interest in Invention to MSU and all patent rights shall reside in MSU, subject to MSU’s compliance with this Agreement and governmental obligations.

2.4 MSU shall promptly record Assignments of domestic patent rights in the United States Patent and Trademark Office and shall provide FSU with a photocopy of each recorded Assignment.

2.5 MSU shall not abandon the prosecution of any patent application (except for purposes of filing continuation or continuation-in-part applications) or the maintenance of any

patent contemplated by this Agreement without prior written notice to FSU at least sixty (60) days prior to loss of rights.

2.6 MSU shall promptly provide to FSU copies of all patents issued pursuant to this Agreement.

2.7 If MSU anticipates the possibility of any extraordinary expenditures arising from the preparation, filing, prosecution, licensing, or defense of any patent application or patent contemplated by this Agreement, MSU shall provide FSU with full particulars and shall discuss with FSU a mutually acceptable course of action prior to incurring such expenditures.

### **3. LICENSING AND REVENUES**

3.1 MSU shall diligently seek licensee(s) for the commercial development of said Invention(s) and shall administer the Invention(s) for the mutual benefit of the parties and in the best public interest.

3.2 MSU shall not issue any royalty-free or paid-up licenses or assign patent rights to any third party, notwithstanding any other provision of this Agreement or governmental consent, without the prior written consent of FSU.

3.3 MSU shall distribute proceeds received by MSU from the licensing of said Invention(s) pursuant to this Agreement as follows:

i. The first eight thousand five hundred dollars (\$8500.00) of Gross Revenue shall be distributed to the Inventors in accordance with the Agreement between the inventors (Appendix A) wherein Mark A. Novotny shall be entitled to a seventy five (75%) percent share and Gyorgy Korniss shall be entitled to a twenty five (25%) percent share.

ii. Expenses incurred by FSU shall be reimbursed from Gross Revenue after the above payment to the inventors. After FSU recovers such expenses, MSU shall be reimbursed for its Expenses.

iii. After the above payments the Net Revenue will be distributed by MSU as follows,

a. In lieu of all payments to the inventors from FSU/FSURF, Forty percent (40%) of Net Revenue shall be paid to the Inventors in accordance with Agreement between the inventors (Appendix A) wherein Mark A. Novotny shall be entitled to 75% of said

payment(s) and Gyorgy Korniss shall be entitled to 25% of such payment (s);

- b. 30% of Net Revenue shall be paid to FSURF; and
- c. MSU will retain 30% of Net Revenue.

3.4 If, in accordance with Section 2.5, MSU elects to discontinue payment of Expenses with respect to any patent or patent application in any particular country, then, notwithstanding the other provisions of this Section 3.3, MSU shall have no further right to receive any proceeds from the commercial exploitation of such patent application or patent in such country.

3.5 MSU shall submit to FSURF an annual Report, not later than April 1 of each year, setting forth the status of all patent prosecution, commercial development, and licensing activity relating to the said Invention(s) for the preceding calendar year.

#### **4. PUBLICATION**

4.1 MSU, FSU, and the Inventors will be free to publish information relating to the Invention in scientific journals.

4.2 MSU, FSU, and the Inventors shall have the right to use the Invention for research and educational purposes.

#### **5. INFRINGEMENT**

If MSU shall learn of the substantial infringement of any patent contemplated by this Agreement, MSU shall use its reasonable efforts to terminate such infringement without litigation. If these efforts are not successful in eliminating the infringement within ninety (90) days after the infringer has been formally notified of the infringement by MSU, MSU or its licensees shall have the right, but not the obligation to seek redress in the courts. Upon notification by MSU, FSU agrees to cooperate in any proceedings instituted hereunder at the expense of the party bringing suit.

#### **6. NOTICES**

Any notice or communication required or permitted under this Agreement shall be made in writing and sent to such party, postage prepaid, and addressed as set out below. However, if the

communication involves an alleged breach of this Agreement or a cancellation of this Agreement, such communication shall be sent by registered or certified mail, and also communicated by telephone as promptly as possible.

MSU:           MISSISSIPPI STATE UNIVERSITY  
Office of Intellectual Property and Technology Licensing  
Post Office Box 5282  
Mississippi State, MS 39762  
Attention: Charles T. Rivenburgh

FSU/FSURF: Florida State University Research Foundation, Inc.  
Kirby W. Kemper  
President  
97 S. Woodward  
Tallahassee, FL 32306-4166

All communications relating to this Agreement shall be deemed to be duly received ten days after mailing or upon actual receipt, whichever is earlier, if sent by Certified Mail, Return Receipt Requested, to the above address, and shall be deemed received the day after transmission if sent by a graphic scanning process (FAX) to the above number. If either party is notified by the other in writing of a change of address or FAX number, any subsequent communication relative to this Agreement shall be sent to the last said notified address or number.

## **7. TERM OF AGREEMENT**

This Agreement shall be in full force and effect from the date first herein written and shall terminate upon either the expiration of all U.S. and foreign patents, the expiration of a License Agreement if it extends beyond the patent termination date, or fifteen (15) years from the effective date of the Agreement, whichever is longer, unless otherwise terminated by operation of law or by acts of parties in accordance with the terms of this Agreement.

## **8. TERMINATION**

Either party may terminate this Agreement upon sixty (60) days written notice to the other party. Upon such termination, the party receiving such notice may elect to continue with the prosecution and maintenance of patent rights in Inventions, hereinafter referred to as the "continuing party" in this Section 8 and Section 9. The allocation of ownership of patents and patent

applications shall be made pursuant to Section 9. Surviving any termination are any obligation to distribute license fees or royalties accrued or accruable, obligation to reimburse Expenses, and any cause of action or claim from either party because of breach or default by the other party.

## **9. ALLOCATION OF RIGHTS AND OBLIGATIONS UPON TERMINATION**

9.1 MSU may terminate this Agreement upon at least sixty (60) days written notice to FSURF, but in any event not less than sixty (60) days prior to the date on which any pending Patent Office actions need be taken to preserve patent rights for the benefit of the parties hereto and Sponsor.

9.2 If MSU terminates this Agreement, FSURF at its sole discretion may elect to request assignment of any or all patent rights acquired by MSU in the Invention(s) and any or all licenses issued by MSU for said Invention(s). FSURF shall make its election and shall advise MSU in writing within thirty (30) days after receipt of notice of termination, and MSU shall thereupon convey to FSURF assignment of the selected patent rights and licenses and shall do all things necessary to transfer file wrappers and other files related to such rights and licenses to FSURF or its designee.

9.3 Upon perfection of assignments provided for in Section 9.2, MSU shall have no further rights or obligations with respect to the selected patent(s) or patent application(s), except to: (a) recover its Expenses incurred prior to termination, and (b) distribute to FSURF and Inventors Net Revenues accrued and accruing under continuing licensing arrangements entered into prior to termination. Such distribution shall be made in accordance with the revenue distribution policy of the continuing party.

9.4 Upon perfection of assignments in accordance with this Section 9, FSURF may thereafter separately license the selected patent(s) or patent application(s), without accounting to MSU, provided, however, that Royalties accrued by the maintaining party from such licensing shall be shared with all Inventor(s), according to the policy of FSU.

9.5 In the event neither MSU nor FSU/FSURF wishes to retain patent rights to Invention(s), MSU shall dispose of Invention(s) pursuant to Sponsor's election if required.

## **10. RECORDS AND REPORTS**

10.1 MSU and FSU shall maintain adequate records showing all Expenses incurred which shall be made available for inspection by a reasonably acceptable certified public accounting

firm on reasonable notice and at the expense of the requestor.

10.2 Upon request by FSURF, MSU will submit to FSURF within sixty (60) days from the request a report giving the status of patent prosecution, commercial development, and licensing activity. FSURF may make such a request no more than once a year.

## **11. ASSIGNABILITY**

Neither party may assign this Agreement without the written permission of the other party.

## **12. WAIVER**

No waiver by any party hereto of any breach or default of any of the covenants or agreements herein set forth shall be deemed a waiver as to any subsequent or similar breach or default.

## **13. SEVERABILITY**

If any provision of this Agreement shall be held to be invalid, illegal, or unenforceable in any respect, the validity, legality, and enforceability of the remaining provisions shall not in any way be affected or impaired thereby, provided that the intent of the parties in entering into the Agreement is not materially affected thereby.

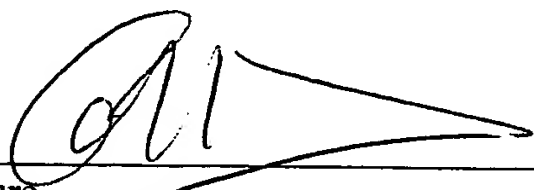
## **14. ENTIRE AGREEMENT**

This Agreement constitutes the entire Agreement between the parties concerning the subject matter hereof. All prior written agreements respecting the subject matter hereof are void. No amendment of this Agreement shall be binding on the parties unless mutually agreed to and executed in writing by each of the parties.

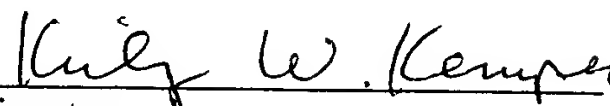


IN WITNESS WHEREOF, the parties have caused this Agreement to be executed by their duly authorized representatives as of the date first written.

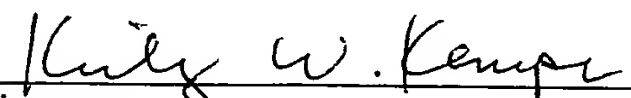
MSU

  
\_\_\_\_\_  
Signature  
Glen Scanes  
\_\_\_\_\_  
(Print Name)  
VP Research  
\_\_\_\_\_  
Date: 4/10/05

FSURF

  
\_\_\_\_\_  
Signature  
Kirby W. Kemper  
President  
Date: 3/9/05

FSU

  
\_\_\_\_\_  
Signature  
Kirby W. Kemper  
Vice President for Research  
3/9/05  
\_\_\_\_\_  
Date